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In re Application of REVIE et al.
Application No.: 10/598,593
PCT No.: PCT/GB05/00855
Int. Filing: 07 March 2005
Priority Date: 03 March 2004
Attorney Docket No.: DEP5300
For: IMPLANTABLE MARKER,
INSTRUMENTS AND METHODS

DECISION ON
DECLARATION

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371 and applicant's submission entitled "Submission of Combined Declaration and Power of Attorney" filed on 13 August 2007 in the United States Patent and Trademark Office (USPTO).

On 11 April 2007, a Notification of Missing Requirements was mailed to applicants indicating that, *inter alia*, an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and 37 CFR §§ 1.66 or 1.68, was required.

On 07 August 2007, a Response to the Notification of Missing Requirements was filed in the USPTO accompanied by executed declarations.

A review of the declarations reveals that the declarations executed by inventor Revie and Nitzan has been altered. The USPTO does not accept a declaration that has been altered.

Section 602.01 of the MPEP states the following:

The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

Moreover, the alteration by inventor Revie is unacceptable as it states "reviewed the contents of the application in March 2004 and have not reviewed since the filing date. At that date I understood the contents of the identified specification". This alteration replaced the lined-

out text: 'have reviewed and understand the contents of the above identified specification.' The altered declaration does not comply with 37 CFR 1.63(b)(2), which states that the person making the oath or declaration has reviewed and understands the contents of the application. Inventor Revie's handwritten statement does not indicate such. Thus, the declaration is unacceptable. Since this alteration goes to the whole declaration and it is unclear which inventors signed this declaration, newly executed declarations are required.

It is also noted that Yaakov Nitzan made an alteration to his execution, apparently correcting his mailing address. This alteration is also unacceptable for the reasons set forth above.

Finally, the declaration appears to be a five page declaration. The declaration papers contain four pages identifying the third inventor through sole or fifth inventor and four pages identifying the sixth through eighth inventor. The declaration appears to be a composite declaration created from the combination of separately executed declarations. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. The declaration is unacceptable as filed and thus, the requirements of 37 CFR 1.497 (a) and (b) have not been met.

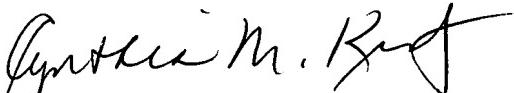
Therefore, a new acceptable oath or declaration executed by the inventors is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

CONCLUSION

A new acceptable oath or declaration executed by the inventors, in compliance with 37 CFR 1.497(a) and (b) and 1.63, is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

This application will be held in the PCT Legal Office, Office of PCT Legal Administration to await applicant's further reply, that is, a newly executed oath or declaration by inventors, in compliance with 37 CFR 1.497(a) and (b). Applicant has one month from the mail date of this decision or the time remaining under the Notification of Missing Requirements within which to reply.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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